

THE HONORABLE JAMES L. ROBART  
SPECIAL MASTER MARK P. WALTERS

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT SEATTLE

CALIFORNIA EXPANDED METAL  
PRODUCTS COMPANY, a California  
corporation; and CLARKWESTERN  
DIETRICH BUILDING SYSTEMS LLC, dba  
CLARKDIETRICH BUILDING SYSTEMS,  
an Ohio limited liability company,

Plaintiffs,

v.

JAMES A. KLEIN, an individual;  
BLAZEFRAME INDUSTRIES, LTD., a  
Washington company; and SAFTI-SEAL,  
INC., a Washington company,

Defendants.

Case No. 18-cv-00659-JLR

**REPORT AND  
RECOMMENDATION RE:  
MOTION BY S4S FOR A  
BRIEFING SCHEDULE ON  
MOTIONS TO STRIKE OR  
EXCLUDE EXPERT TESTIMONY**

THIS MATTER is before the Special Master on a motion by Seal4Safti, Inc. (“S4S”)<sup>1</sup> requesting a briefing schedule for motions to strike or exclude expert testimony submitted in declarations and written reports from three witnesses offered by Plaintiffs California Expanded Metal Products (“CEMCO”) and Clarkwestern Dietrich Building Systems LLC (“ClarkDietrich”) (collectively “Plaintiffs”) in support of their motion for contempt submitted to the Special Master on September 8, 2021.

<sup>1</sup> S4S is a not a party to the underlying litigation, but it was added to these contempt proceedings on September 1, 2021, based on a finding by the Court that it was “legally identified” with Defendant Safti-Seal, Inc. (Dkt. No. 251.)

## BACKGROUND

The three witnesses supporting Plaintiffs' motion for contempt are Don Pilz, Eric Bergman, and Richard N. Walke. Mr. Pilz is "the research and development product manager" for CEMCO and he offers approximately 28 pages of testimony with 114 exhibits mostly comparing listings published by Underwriters Laboratory ("UL") including the enjoined "SaftiFrame" and "SaftiStrip" products and the products accused of violating the injunction known as "Fire Rated Gasket" or "FRG" products. Mr. Pilz's declaration offered in support of Plaintiff's motion for contempt is largely the same as the one filed by Plaintiff's in support of their motion to reopen the case on June 22, 2020 (Dkt. No. 170), except that the new Pilz declaration includes new exhibits 84-114, which Plaintiffs describe as "copies of S4S's own UL Listed Assemblies and updated product profiles and installation instructions for S4S products from the S4S website, many of which were submitted with the original Pilz Declaration." (Email from Francis Wong dated 9-21-2021.) During a hearing held on September 21, 2021, counsel for S4S noted that the new Pilz declaration also contains "a table . . . that's all about U-shaped tracks . . . that takes up a page and half," which table was not presented in the original Pilz declaration. (Hearing held on 9-21-2021 (Rough Draft) at 8:6-9.)

Mr. Bergman is the Operations Manager and a Senior Firestop Consultant for Braun Internec Corporation, an engineering and consulting firm, who was retained by the Plaintiffs to provide expert testimony in this matter. (Bergman Rep. ¶1.) Mr. Bergman was asked to compare UL listed assemblies specifying the enjoined SaftiStrip product to newer UL listings specifying the FRG product. Specifically, Mr. Bergman was "asked to explain the similarities and differences, if any, between the [enjoined SaftiStrip] intumescent strip and

1 the FRG intumescent strip in the context of UL approvals for use in firestopping  
2 applications based on [his] experience and expertise.” (*Id.*, ¶16.)

3 Mr. Walke is the Technical Director of Creative Technology Inc., “retained by  
4 [Plaintiffs] to provide expert testimony.” (Walk Decl. ¶1.) Mr. Walke was “employed by  
5 [UL] for a total of forty-three years in various technical positions and [has] thirteen years  
6 of experience testing joint systems in accordance with UL 2079.” (*Id.*, ¶2.) Mr. Walke was  
7 asked “by Plaintiffs to assess the decision-making process used by [UL] during the  
8 transition of nineteen UL joint systems using Safti-Seal, Inc.’s Safti-Frame and Safti-Strip  
9 series of products to a new series of twenty-one joint systems using [S4S’s] FRG Composite  
10 Thermal Gasket series of products.” (*Id.*, ¶3.) Both the Bergman and Walke expert reports  
11 were served on counsel for S4S on June 2, 2021. (Email from R. Joseph Trojan dated 9-20-  
12 2021.)  
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15 S4S requests a briefing schedule and opportunity to file separate motions to strike  
16 or exclude the expert testimony offered by Plaintiffs. Specifically, S4S notes that the  
17 briefing schedule recommended by the Special Master on March 10, 2021 (Dkt. No. 211)  
18 and adopted by the Court on March 26, 2021 (Dkt. No. 212) “did not include any reference  
19 to expert disclosures, discovery, or testimony,” and that because S4S was only made a party  
20 to these proceedings on September 1, 2021, it has not had a fair or complete opportunity to  
21 take discovery of experts or to otherwise challenge the admissibility of expert opinion  
22 pertaining to the question of contempt currently before the Court. (Email from KC Hovda  
23 dated 9-20-2021.) Plaintiffs respond that S4S has been determined by the Court to have “no  
24 separate identity outside of [Defendant] SaftiSeal” (Dkt. No. 251) and for that reason, S4S  
25  
26 has been a party to all discussions regarding the proposed schedule leading up to when it

1 was added to these contempt proceedings as of September 1, 2021, and that in any event,  
 2 S4S received both the Walke and Bergman reports on June 2, 2021, and had fair notice of  
 3 the content of Mr. Pilz's report as of the time it was filed in June 2020. (Email from R.  
 4 Joseph Trojan dated 9-20-2021 (discussing service of the Bergman and Walke reports);  
 5 Email from Francis Wong dated 9-21-2021 (discussing the Pilz report filed 6-22-2020 in  
 6 comparison to the Pilz Report submitted to the Special Master on 9-8-2021).)

## 8 ANALYSIS

### 9 A. The Role of Expert Testimony in Contempt Proceedings

10 The Federal Circuit provides that "[i]f substantial issues need to be litigated,  
 11 particularly if expert and other testimony subject to cross-examination would be helpful or  
 12 necessary, the court may properly require a supplemental or new complaint." *KSM*  
 13 *Fastening Systems, Inc. v. H.A. Jones Co.*, 776 F.2d 1522, 1531 (Fed Cir. 1985) *overruled*  
 14 *in-part by Tivo Inc. v. Echostar Corp.*, 646 F.3d 869, 881 (Fed. Cir. 2011). This is so  
 15 because the need to rely on expert opinion testimony within the context of contempt  
 16 proceedings may indicate that "substantial open issues" must be tried, making contempt  
 17 proceedings inappropriate. *Arbek Mfg., Inc. v. Moazzam*, 55 F.3d 1567, 1570 (Fed Cir.  
 18 1995).

20 Notably, after *Tivo*, the Federal Circuit rejects an "infringement-based  
 21 understanding of the colorably different test" and instead focuses on "the differences  
 22 between the features relied upon to establish infringement and the modified features of the  
 23 newly accused products." *Tivo*, 646 F.3d at 882. "The primary question on contempt should  
 24 be whether the newly accused product is so different from the product previously found to  
 25 infringe that it raises 'a fair ground of doubt as to the wrongfulness of the defendant's  
 26

conduct.” *Id.* (quoting *Cal. Artificial Stone Paving Co. v. Molitor*, 113 U.S. 609, 618, 5 S. Ct. 618, 28 L.Ed. 1106 (1885)).

Specifically, one should focus on those elements of the adjudged infringing products that the patentee previously contended, and proved, satisfy specific limitations of the asserted claims. Where one or more of those elements previously found to infringe has been modified, or removed, the court must make an inquiry into whether that modification is significant. *If those differences between the old and new elements are significant*, the newly accused product as a whole shall be deemed more than colorably different from the adjudged infringing one, and the inquiry into whether the newly accused product actually infringes is irrelevant. Contempt is then inappropriate.

*Id.* (emphasis added) (citing *Arbek*, 55 F.3d at 1570). In determining whether significant differences exist between the two products, “much is dependent on the nature of the products at issue” and the Court may consider whether “the modification merely employs or combines elements already known in the prior art in a manner that would have been obvious to a person of ordinary skill in the art at the time the modification was made.” *Id.* “[A] district court may seek expert testimony in making the determination” and “[t]he analysis may also take account of the policy that legitimate design-around efforts should always be encouraged as a path to spur further innovation.” *Id.* at 883.

When a determination is made that there are no more than colorable differences between the adjudged infringing product and the modified product, district courts must still “evaluate the modified elements of the newly accused product against the asserted claim, on a limitation by limitation basis, to ensure that each limitation continues to be met” and “out of fairness, the district court is bound by any prior claim construction that it had performed in the case.” *Id.* (citing *KSM*, 776 F.2d at 1528).

Accordingly, based on application of the “colorably different test” in *Tivo*, expert

1 testimony may be considered by district courts to determine the significance of any  
 2 difference between the product previously adjudged to be infringing and the modified  
 3 product, however, to the extent that testimony identifies new or open issues, particularly  
 4 issues requiring modification to the court's claim construction or application of that claim  
 5 construction to a new or substitute feature in the modified device, the testimony may require  
 6 evaluation by the fact finder "in a new infringement proceeding" because such questions  
 7 "should not be decided in a contempt proceeding." *Id.* at 884.

9 Whether the expert testimony in this case identifies any such open issues has not  
 10 been determined and will be addressed in the Special Master's recommendation and report  
 11 evaluating the evidence and briefing on Plaintiffs' motion for contempt.

12 **B. S4S's Request for A Briefing Schedule for Motions to Exclude or Strike**  
 13 **Plaintiff's Expert Testimony**

14 The Special Master recommends that the Court provide S4S additional time to  
 15 oppose the motion for contempt in view of the additional or modified information that was  
 16 included in the declaration by Mr. Pilz served on September 8, 2021, but that the Court deny  
 17 S4S's request for a separate briefing schedule for motions to strike or exclude expert  
 18 testimony. These contempt proceedings have already been pending for more than a year and  
 19 S4S has understood, at least since June 2, 2021, that Plaintiffs intended to rely in-part on  
 20 expert testimony to prove their allegations of contempt. Further, on June 2, 2021, counsel  
 21 for S4S signed an agreement to be bound by the protective order in this case, and as of that  
 22 time, S4S had access to any confidential materials appended to the expert reports. (Email  
 23 from R. Joseph Trojan dated 9-20-2021 (attaching email from June 2, 2021, acknowledging  
 24 signed agreement by S4S to be bound by the protective order).) While S4S was not  
 25  
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1 determined to be within the scope of the injunction until September 1, 2021 (Dkt. No. 251),  
2 counsel for S4S was served as an interested party (Dkt. No. 209) with the Special Master's  
3 report and recommendation on S4S's motion to quash certain deposition subpoena's and  
4 setting a new briefing schedule on Plaintiffs' motion for contempt (Dkt. No. 211). S4S also  
5 received the Court's order setting the briefing schedule, which was entered sixteen days  
6 after the Special Master's report and recommendation on the schedule. (Dkt. No. 212.) No  
7 objection was made at that time to the proposed schedule, nor did S4S serve any objections  
8 to the expert reports following service on June 2, 2021. (Hearing held on 9-21-2021 (Rough  
9 Draft) at 8:18-9:1 (noting that "[t]his is all being done at the last minute" and that until now,  
10 S4S had not served objections to any of the expert reports).)

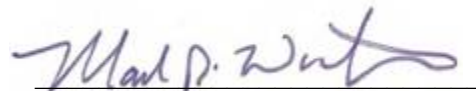
11  
12 Accordingly, S4S's silence on the proposed briefing schedule, particularly the fact  
13 that it did not provide for separate briefing on motions to exclude or strike expert testimony,  
14 indicates an agreement by S4S that any such issues may be properly determined within the  
15 context of Plaintiffs' motion for contempt and that separate discovery by S4S into the facts  
16 and opinions stated in those reports as of June 2, 2021, most of which is aimed at products  
17 made and sold by S4S, was not necessary. The Special Master notes further that insofar as  
18 the Court has already determined that S4S is "legally identified" with Defendant Safti-Seal,  
19 Inc., S4S has known or should have known about the detailed accusations of infringement  
20 contained in the declaration of Don Pilz filed June 22, 2020. (Dkt. No. 170.)

21  
22 Finally, because contempt proceedings are necessarily limited to a determination  
23 whether the new or modified products are nor more than colorably different from the  
24 products adjudged to be infringing, and if so, whether the new or modified products include  
25 all elements of the infringed claim or claims according to the Court's claim construction,  
26

1 *Tivo*, 646 F.3d at 882-884, the role of expert testimony in contempt proceedings is limited.  
2 Arguments that expert testimony shows substantial differences between the infringing  
3 products and the new or modified products, that it depends on modifications to the Court's  
4 claim construction, or that it raises genuine issues of material fact requiring new application  
5 of the Court's claim construction to the new or modified products, can be made within the  
6 context of a motion for contempt. A separate briefing schedule on whether the expert  
7 testimony offered in this case is admissible or relevant is not necessary, nor did S4S seek  
8 that relief when the schedule was set.  
9

10 For the reasons stated above, the Special Master recommends that the Court deny  
11 S4S's motion for a separate briefing schedule on motions to strike or exclude expert  
12 testimony relied on by Plaintiffs to support their motion for contempt, but that the Court  
13 allow S4S additional time to include arguments in opposition to Plaintiffs' motion for  
14 contempt based on the inclusion of new information or material in the declaration of Don  
15 Pilz served September 8, 2021. The Special Master recommends that the noting date for  
16 Plaintiffs' motion for contempt be extended from October 1, 2021, to October 15, 2021, and  
17 that all oppositions to the motion be due no later than Monday, October 11, 2021.  
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19 Dated this 22<sup>nd</sup> day of September, 2021  
20  
21

22 

23 Mark P. Walters  
24 Special Master  
25  
26



**CERTIFICATE OF SERVICE**

I certify that on September 22, 2021, a copy of this pleading was filed electronically with the Clerk of the Court using the CM/ECF system. Notice of this filing will be sent to all counsel of record via the court's electronic filing system.

/s/Rischel Voigt  
Rischel Voigt, Paralegal